

Remarks

Reconsideration of this Application is respectfully requested. Claims 1 and 3-14 are pending in the application, with claims 1 and 9 being the independent claims.

Rejections Under 35 U.S.C. 101

Claims 1-8 were rejected under 35 U.S.C. 101 as being directed toward non-statutory subject matter. The Examiner stated that claims 1-8 were “not limited by language within the technological arts... even though said claims may be limited to a useful, concrete, and tangible application.” The Examiner also stated that the claim language was “merely nonfunctional descriptive material disembodied from the technological arts.”

Applicant respectfully traverses these rejections under 35 U.S.C. 101. Independent claim 1 recites “...*recording in a memory*, an identifier associated with one of the artifacts wherein the recording occurs in response to a visitor selection while the visitor is positioned within the public space; and responsive to the recorded identifier, providing access to additional information relating to the artifact associated with the recorded identifier.” Applicant asserts that claim 1 is limited by language within the technological arts. The term “memory” is defined as “[a]ll of the addressable storage in a processing unit and other internal storage that is used to execute instructions.” The IEEE Standard Dictionary of Electrical and Electronic Terms (6th ed. 1997). Also, it is necessary to store the user’s selections in memory so they can be used to provide access to additional information about the selections. Therefore, the claim language is not disembodied from the technological arts.

Furthermore, the Applicant has amended independent claim 1 to more specifically recite both a portable electronic selection device and a communications network. Both of these

elements are clearly embodiments of the technological arts. Therefore, claim 1 as amended now includes language that further ties it to the technological arts.

In view of the elements highlighted above, reconsideration of the §101 rejection of claim 1 is respectfully requested. Furthermore, since claims 3 to 8 all include the elements of claim 1, they comply with the requirements of 35 U.S.C. §101 for at least the same reasons.

Rejections Under 35 U.S.C. 103(a)

Claims 1-14 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,333,257 to Merrill et al. (“Merrill”) in view of U.S. Patent No. 6,085,976 to Sehr (“Sehr”).

Independent Claim 1 and its Dependent Claims

The Merrill/Sehr Rejection

Regarding independent claim 1, the Office Action states that Merrill discloses “public space” and “artifacts.” However, unlike the present invention, the system in Merrill displays views of a public space to help the user select seating choices from a remote location. The purpose of Merrill is to obviate the need for the user to visit the public space in order to select a seat; instead, the user takes a virtual tour that shows the view seen from each seating choice in the public space. The utility of Merrill is complete once the user has selected a seat, and before the user visits the public space. In contrast, claim requires that there be the capability of selecting an artifact of interest during the user’s physical visit to a public space. Therefore, Merrill does not disclose or suggest the claimed method of recording a visitor selection on a portable electronic selection device as the visitor is physically present in the public space.

In rejecting independent claim 1, the Examiner fails to show how Merrill, Sehr, or their combination recites or suggests the limitation “...wherein the recording occurs in response to a

visitor selection *while the visitor is positioned within the public space....*” The Examiner makes no reference to the quoted claim language, which recites a limitation that is patentable over the prior art. In order to establish a *prima facie* case of obviousness, “...all the claim limitations must be taught or suggested by the prior art.... ‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’” MPEP, 2143.03 (p. 2100-133). As discussed above, Merrill allows the user to take a virtual tour of a public space without physically visiting the facility. Also, in Sehr the user records biometric and payment information onto a portable passenger card before taking a trip, not while viewing artifacts in a public space. Therefore, Merrill, Sehr, or their combination does not teach or suggest the limitation of recording the user’s selection while the user is physically present in the public space.

In addition, neither Merrill nor Sehr discloses or suggests the portable selection device recited in dependent claim 1. In Merrill the selection device is fixed, and in Sehr the portable card does not allow the user to make and record selections while visiting a public space.

For the reasons discussed above, Applicant believes that independent claim 1 is nonobvious. Therefore, dependent claims 3-8 are also nonobvious.

The Rejections Relying on Official Notice

In rejecting dependent claims 5-8, the Examiner states that “Merrill in view of Sehr lacks an explicit recitation of the elements and limitations of claims 5-8, even though Merrill in view of Sehr suggests same.” However, the Examiner does not demonstrate how the combination of these two references suggests any of the elements or limitations in claims 5-8. Instead, the Examiner takes Official Notice that “...both the concepts and the advantages of the elements and limitations of claims 5-8 were well known and expected in the art by one of ordinary skill at the

time of the invention because such concepts and advantages would have provided means that ‘allows the ticket customer to see an approximation of that view for a particular event configuration....’ (see Merrill (col. 1, ll. 31-33)) and because such combination would have provided ‘a portable... card to store, process and communicate cardholder data... and electronic payment means....’ (see Sehr (col. 3, ll. 1-4).”

According to the MPEP, “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP, 2144.03 A (p. 2100-136). Instead, “...the Board [or Examiner] must point to some concrete evidence in the record in support of these findings.” *Id.* at 2100-137. Despite citing Merrill and Sehr, the Examiner provides no concrete evidence that either reference suggests any of the specific elements or limitations recited in claims 5-8. Because the Examiner was unable to cite a prior art reference for these claims, Applicant believes that the elements and limitations are not capable of instant and unquestionable demonstration as being well known. Therefore, it was inappropriate for the Examiner to take Official Notice of these features.

The MPEP also states that “[i]n certain older cases, official notice has been taken of a fact that is asserted to be ‘common knowledge’ without specific reliance on documentary evidence where the fact noticed was readily verifiable, such as when other references of record supported the noticed fact, or where there was nothing of record to contradict it. See *In re Soli*, 317 F.2d 941, 945-46, 137 USPQ 797, 800 (CCPA 1963)...; *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943).... If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound

technical and scientific reasoning to support his or her conclusion of common knowledge.”

MPEP, 2144.03 B (p. 2100-137). The Examiner’s statement does not address any of the limitations in claims 5-8, or describe the reasoning used to take Official Notice of facts that the Examiner claims were well known in the art. Therefore, the Official Notice taken of facts unsupported by documentary evidence without presenting the underlying technical line of reasoning was inappropriate.

Based upon the reasons cited above, Applicant challenges the Examiner’s taking of Official Notice of the concepts and advantages of the elements and limitations of claims 5-8. Applicant demands that the Examiner produce authority for the Official Notice in the next Office Action from the Patent Office. Under the MPEP, “(‘the Board [or examiner] must point to some concrete evidence in the record in support of these findings’ to satisfy the substantial evidence test.) If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding.” MPEP, 2144.04 C (p. 2100-138). Applicant asserts that the limitations in claims 5-8 were not common knowledge or well known in the art.

In response to Applicant’s request for reconsideration (paper 17, filed 10/22/03), the Examiner stated Applicant’s arguments regarding claims 5-8 and 11-14 were “moot because Applicant failed to seasonably challenge the Official Notice evidence in a prior Office Action.” Applicant respectfully traverses the position that Applicant did not seasonably challenge the Official Notice taken in the Office Action mailed on September 25, 2002. In the response to the Examiner’s rejection of claims 5-8, Applicant stated that “[r]eferences to ‘concepts’ and ‘advantages’ do not specifically address the particular features recited in the claims. Therefore,

the Examiner has improperly relied on the Applicant's own teaching and combined it with speculation to fill an acknowledged gap in any combination of *Merrill* and *Sehr*. Applicant requests that the Examiner address the deficiencies in the Official Notice in the next communication from the Patent Office." Applicant noted that the Official Notice taken for dependent claims 11-14 was also deficient, and requested that the Examiner address the deficiencies in both Official Notices.

Applicant challenged the Official Notice in the next reply after the Office Action in which Official Notice was taken, thereby meeting the requirements cited by the Examiner in the Office Action mailed on May 8, 2003 ("[A]pplicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made").

Although Applicant did not explicitly demand a reference in support of the Official Notice evidence, Applicant pointed out the deficiencies in the Official Notice, and requested that the Examiner address these deficiencies in the next Office Action, as required by MPEP 2144.03 ("If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.")

Because Applicant argued that the Examiner improperly relied upon Applicant's own teaching, and the Examiner acknowledged that neither cited reference suggested the elements and limitations of the claims, Applicant's request constituted a demand that the Examiner produce authority for the Official Notice statement. Therefore, it was inappropriate for the Examiner to take the Officially Noted statements as admitted prior art. As discussed above, the Examiner must provide concrete evidence of the finding in the next Office Action.

Independent Claim 9 and its Dependent Claims

Regarding independent claim 9, the Examiner again states that Merrill discloses “public space” and “artifacts.” In addition, “...the Examiner interprets the plurality of identified seating choices as showing ‘a unique identifier associated with an artifact when positioned within the public space....’” Applicant repeats the above arguments that because the invention in Merrill is only employed before the user enters the public space, it does not suggest the limitation of the current invention, in which the user only selects and records identifiers while physically present in the public space.

Independent claim 9 has been rejected using the same combination of references as independent claim 1. Applicant respectfully disagrees with this rejection, and believes that claim 9 is allowable for at least the same reasons as discussed above with respect to claim 1. For at least these reasons, Applicant believes that claim 9 is in condition for allowance. Because claim 9 is nonobvious, its dependent claims 10-14 are also nonobvious and allowable.

Conclusion

All of the stated grounds of rejection have been properly traversed or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicant believes that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that further personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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